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D E C I S I O N
of 22 May 2001

Case Number: T 1206/97 - 3.3.2

Application Number: 91306461.4

Publication Number: 0473270

IPC: A23J 3/08

Language of the proceedings: EN

Title of invention:

Method for preparing a transparent adjusted milk whey protein
and an adjusted milk whey protein product

Patentee:

DAIICHI KASEI CO., LTD.

Opponent:

Snow Brand Milk Products Co., Ltd.
Stichting Behartiging Octrooibelangen

Headword:

Method for preparing milk whey product/DAIICHI KASEI

Relevant legal provisions:

EPC Art. 111(1)(2)

EPC R. 57a

Keyword:

"Remittal - yes: subject-matter not examined by first instance"

Decisions cited:

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Catchword:

-



Case Number: T 1206/97 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 22 May 2001

Appellant:
(Proprietor of the patent)

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Representative:

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Respondent:
(Opponent 01)

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Representative:

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Respondent:
(Opponent 02)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 13 October 1997
revoking European patent No. 0 473 270 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
S. U. Hoffmann

Summary of Facts and Submissions

- I. European patent No. 0 473 270 based on application No. 91 306 461.4 was granted on the basis of two independent claims.

Independent claims 1 and 2 as granted read as follows:

"1. A method for preparing of a transparent milk whey protein product, characterized in that milk whey protein is purified, a solution containing said milk whey protein and at a pH of below 4 or above 6 and having a total salt content of not higher than 50 mM is heated to a temperature not lower than 55°C to obtain a transparent solution, at least one salt is added to said transparent solution, the pH of said solution is adjusted again to below 4 or above 6 and said solution is heated.

2. A method for the preparation of a transparent milk whey protein product, characterized in that milk whey protein is purified, a solution containing said milk whey protein and at a pH of below 4 or above 6 and having a salt content not higher than 50 mM is heated to a temperature not lower than 55°C to obtain a transparent solution, and the transparent solution is cooled to a temperature not higher than 10°C."

- II. Notices of opposition were filed against the granted patent by the respondents (opponent 01 and opponent 02).

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step and under Article 100(b) EPC for insufficiency of disclosure.

The following document *inter alia* was cited during the proceedings.

(3) (J. Food Proc. Pres., 2 (1978), pages 111 to 121)

III. The decision of the Opposition Division, pronounced on 25 September 1997 and posted on 13 October 1997, revoked the patent under Article 102(1) EPC.

The Opposition Division took the view that the subject-matter of claim 2 of the patent in suit did not meet the requirements of Article 54 EPC.

In its opinion, document (3) anticipated the subject-matter of the independent process claim 2. Document (3) described a method which comprised first heating at 100°C a solution of purified and dialysed whey protein at pH 7 and then cooling it in an ice bath. Although this document did not mention *expressis verbis* the salt content of the dialysed solution containing the purified milk whey protein used in the process, the Opposition Division held that it should be the same as the one in the process of the contested patent, since the same purification step was carried out in both documents. It accordingly concluded that all the features of claim 2 of the patent in suit were disclosed in document (3).

IV. The appellant (patentee) lodged an appeal against the said decision.

V. In a letter dated 19 April 2001, the appellant filed a new claim as the main request, which corresponded to claim 1 as granted, wherein the wording "at least one salt" was replaced by "a salt for flavouring".

VI. In a fax dated 18 May 2001, the Board pointed out that the subject-matter of the single claim of said main request appeared to contravene the requirements of Articles 123(2) and 84 EPC.

VII. Oral proceedings were held before the Board on 22 May 2001.

At the beginning of the oral proceedings, the appellant filed two amended claims as main and auxiliary requests respectively. The appellant submitted that the case should be remitted to the first instance in order to have an appealable decision at least on the main request. In its opinion, the subject-matter of this request had not so far been considered by the Opposition Division. The claim of the main request reads as follows:

"A method for preparing of a transparent milk whey protein product, characterized in that milk whey protein is purified, a solution containing said milk whey protein at a pH of below 4 or above 6 and having a total salt content of not higher than 50 mM (millimolar) is heated to a temperature not lower than 55 deg. C to obtain a transparent solution, the pH of said transparent solution is adjusted again to below 4 or above 6, and then a salt for flavouring is added to said transparent solution, and then the resulting solution is heated." (Emphasis added).

VIII. The respondents (opponent 01 and 02) shared the opinion of the appellant and argued that, having regard to the complexity of the new subject-matter, it would be fair to have the case decided by two instances.

IX. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the main request filed during the oral proceedings or auxiliary on the basis of the auxiliary request filed during the oral proceedings.

The respondents requested that the appeal be dismissed and auxiliarily that the case be remitted to the first instance for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. The subject-matter of the main request differs from the set of claims as granted in that the independent claim 2 as granted was deleted and the independent claim 1 as granted amended (see above under points I and VII).

The Board notes that the decision of the opposition division does not contain any statement as to the patentability of independent claim 1 as granted but exclusively relates to independent claim 2 as granted and that the deletion of the independent claim 2 as granted was occasioned by a novelty objection, with respect to this claim. Moreover, the amendments in claim 1 were made in order to try to comply with the objections under Articles 123 and 84 EPC raised by the Board (see above under point VI).

Accordingly, the Board judges that the filing of said amended claim fulfils the requirements of Rule 57a EPC.

3. The Opposition Division concluded in essence that the subject-matter of independent claim 2 of the patent in suit was anticipated by the disclosure in document (3), because the heating step of a purified whey protein solution having a salt content of not higher than 50 mM and the cooling step of the resulting transparent solution were both described in this document.

However, according to the main request in the appeal proceedings, independent claim 2 as granted is now deleted and the subject-matter of the single claim of this main request now refers to the combination of the steps of adjusting the pH of the transparent solution of purified milk whey protein, adding a salt to it and heating the resulting solution.

Moreover, in this amended process, the step of pH adjustment precedes the addition of salt, whereas in the granted claim 1 these steps were reversed.

Thus, the findings of the Opposition Division, ie that the patent had to be revoked because the subject-matter of the independent claim 2 of the patent in suit was not novel, does not hold good for the single claim of the main request and for these reasons the decision under appeal has to be set aside.

4. Although Article 111(1) EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances, that may well be appropriate as regards essential issues. Hence, cases are often referred back, if essential questions regarding the patentability of the claimed subject-matter have not been examined and decided by the department of first instance.

Accordingly, in view of the reasoning under point 3 above, the Board has reached the conclusion that, in the circumstances of the present case, it is appropriate to remit the case to the Opposition Division.

Particularly, since the subject-matter of independent claim 1 as granted was not examined during the opposition proceedings.

Moreover, in the present case, where the appellant and the respondents both requested the remittal of the main request to the first instance without any examination with respect to formal allowability as well (Articles 123 and 84 EPC), the Board does not find it appropriate to bind the Opposition Division (Article 111(2) EPC) by a final decision on this issue.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the main request filed during the oral proceedings.

The Registrar:

The Chairman:

A. Townend

U. Oswald